REMARKS

Summary of Office Action

Claims 1-27 are pending in the above-identified application.

Claims 26-27 have been provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1 and 2.

Claims 1-25 have been provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-33 of copending Bumgardner et al. U.S. Patent Application No. 10/605,246 ("Bumgardner").

Claims 1-27 have been rejected under 35 U.S.C. § 102(a) as being anticipated by Cheng et al. European Patent Application EP 1355496 ("Cheng").

Summary of Applicants' Reply

Applicants have amended claims 1, 3-6, 8-9, 11-14, 16-17, 19-22, and 24 to more particularly define the claimed invention.

Applicants have cancelled claims 2, 7, 10, 15, 18, 23, and 25-27 without prejudice.

The Examiner's rejections are respectfully traversed.

Applicants' Reply to the
35 U.S.C. § 101 Rejections

Claims 26-27 have been provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1 and 2 of this same application.

Claims 1-25 have been provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-33 of copending Bumgardner et al. U.S. Patent Application No. 10/605,246 ("Bumgardner").

Claims 26-27

As indicated in MPEP § 804.I, "a double patenting issue may arise [under 35 U.S.C. § 101] between two or more pending applications" (emphasis added). Clearly, a double patenting rejection requires two or more applications and therefore claims in a single application cannot raise a double patenting rejection for other claims within that same application. Accordingly, applicants respectfully submit that the 35 U.S.C. § 101 rejection of claims 26-27 is improper and should be withdrawn.

Furthermore, applicants note that they have cancelled claims 26-27. Accordingly, applicants additionally submit that the 35 U.S.C. § 101 rejection of claims 26-27 is now moot.

Claims 1-25

Applicants respectfully bring to the Examiner's attention that claims 1-33 of Bumgardner were cancelled and replaced by new claims 34-66 in a Reply to Office Action dated February 26, 2008.

Regarding statutory double patenting, MPEP § 804.II.A states that:

> A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent . . . Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantively

> the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine."

Applying this test to applicants' claims 1-25 shows that, as amended, they do not claim the same invention as that of claims 1-33 of Bumgardner. In particular, applicants' claims 1-25 are directed to a first and second storage device that are available to a network. Claims 1-33 of Bumgardner are directed to determining when all tuners in a first video recorder are unavailable, and then using a tuner in a second video recorder. Accordingly, applicants respectfully submit that the 35 U.S.C. § 101 rejection of claims 1-25 be withdrawn.

Nonetheless, applicants believe that, even prior to amending claims 1-25, the 35 U.S.C. § 101 double patenting rejection of claims 1-25 was improper since the scope of the term "video recorder" of Bumgardner's claims is not the same as that of the term "set-top box" of applicants' claims. Applying the MPEP § 804.II.A test referenced above, applicants note that there could clearly be an embodiment of an invention which could literally infringe on Bumgardner's claims without literally infringing applicants' claims.

Applicants' Reply to the
35 U.S.C. § 102(e) Rejections

Claims 1-27 are rejected under 35 U.S.C. § 102(a) as being anticipated by Cheng. These rejections are respectfully traversed.

Independent claims 1, 9, and 16-17, as amended, are directed to a method, networks, and computer program

product for using a storage device. At least a first set-top box including a first storage device and second set-top box including a second storage device are connected in a network. The first set-top box can receive a command that requires at least one storage device of the first and second storage devices.

Cheng is directed to a system for allocating tuner resources in a distributed system or network (Cheng, column 4, lines 32-33). Based on tuner rules and tuner priorities, a central server allocates tuners in a network or system to a consumer (Cheng, column 2, lines 45-51).

Contrary to the Examiner's contention, Cheng fails to show or suggest all of the features of applicants' claimed invention. In particular, Cheng describes a system that relates only to tuner resources and their allocation to consumers (Cheng, column 5, lines 51-56 and FIG. 2). Cheng does not show or suggest "a first storage device included in said first set-top box" and "a second storage device included in said second set-top box", where the first set-top box can receive a command that requires at least one storage device of the first and second storage devices, as required by applicants' claims.

For at least the foregoing reasons, Cheng fails to show or suggest all of the features of applicants' independent claims 1, 9, and 16-17. Accordingly, applicants respectfully submit that independent claims 1, 9, and 16-17, and their respective dependent claims, are allowable over Cheng. Applicants respectfully request that the 35 U.S.C. § 102(a) rejection of claims 1-27 be withdrawn.

Conclusion

In view of the foregoing, applicants respectfully submit that this application, as amended, is in condition for allowance. Reconsideration and prompt allowance are respectfully requested.

Respectfully submitted,

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